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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SHEPARD, JUSTIN E

ART UNIT

PAPER NUMBER

2623

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/081,410

Applicant(s)

SHIMIZU ET AL.

Examiner

Justin E. Shepard

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by Adams.

Referring to claim 2, Adams discloses a data communication system for transmitting and receiving data (column 2, lines 48-49; figure 3, part 105, including: a transmitting device for transmitting first data (column 1, line 21; column 2, lines 48-49; Note: the data is being provided to the decoding system from a transmitting device, a video server for example); and a communication terminal including: a receiving unit for receiving the first data transmitted from the transmitting device (figure 3, part 105); a first storage for storing the first data received by the receiving unit (figure 3, part 121; column 2, lines 52-57); a second storage for storing second data different from the first data (figure 3, part 131; column 2, lines 57-59); a reading unit for reading out data stored in the first storage or second storage (figure 3, part 115); a display unit for displaying the data read out by the reading unit (column 5, lines 12-15); a measuring unit for measuring an amount of the first data stored in the first storage (figure 4; column 5, lines 39-43; Note: it would be inherent for a device that switched output to include a measuring device. The system starts one stream when another stream ends, as shown at T3 in figure 4. The device indicates when the first stream ends, which would be a

measuring device indicating when the first buffer is empty); and a control unit for performing control such that the reading unit reads out data from the first storage or second storage (figure 3, parts 150 and 110).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 5, 6, 7, 13, 14, 15, 16, 17, 19, 21, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams in view of Armstrong.

Referring to claim 1, Adams discloses a data communication system for transmitting and receiving data between a transmitting device and a communication terminal, wherein the transmitting device comprises:

a data memory for storing a plurality of data (column 1, line 21; column 2, lines 48-49; Note: see rejection of claim 2);

a selecting unit for selecting the first data from the data memory (figure 3, part 115); and

a transmitting unit for transmitting the first data to the communication terminal (column 1, line 21); and wherein the communication terminal comprises:

a data receiving unit for receiving the first data transmitted from the transmitting device (figure 3, part 105);

a first storage for storing the first data received by the data receiving unit (figure 3, part 121; column 2, lines 52-57);

a second storage for storing second data different from the first data (figure 3, part 131; column 2, lines 57-59);

a reading unit for reading out data stored in the first storage or second storage (figure 3, part 115);

a display unit for displaying the data read out by the reading unit (column 5, lines 12-15); and

a control unit for performing control such that the data from the first storage or second storage is read out according to an amount of the first data stored in the first storage (figure 4; column 5, lines 39-43; figure 3, parts 150 and 110).

Adams does not disclose a receiving unit for receiving a request to transmit first data from the communication terminal; and a request transmitting unit for transmitting a request to send the first data to the transmitting device.

Armstrong discloses a receiving unit for receiving a request to transmit first data from the communication terminal (column 3, lines 8-9); and a request transmitting unit for transmitting a request to send the first data to the transmitting device (column 3, lines 61-64).

At the time of the invention it would have been obvious to one of ordinary skill in the art to add the video requesting taught by Armstrong to the system disclosed by Adams. The motivation would have been to allow the user to have more viewing options.

Claims 3 and 13 are rejected on the same grounds as claim 1, except for the limitation of a control unit for performing control over the reading unit such that, when an amount of the first data is less than a predetermined amount, the second data is read out from the second storage.

Adams discloses a system wherein the stream being processed by the first decompression circuit ends, which causes the second video stream to be transmitted to the output bus (column 5, lines 39-43). This system discloses a control unit for performing control over the reading unit such that (figure 3, parts 110 and 150), when an amount of the first data is less than a predetermined amount (column 5, lines 39-40; Note: the predetermined amount in this case would be zero, or that the buffer was empty), the second data is read out from the second storage (column 5, lines 40-43).

Referring to claim 4, Adams discloses a data communication system according to claim 1, wherein the first data is moving image data, and the second data is commercial message data (column 6, lines 21-23).

Claim 14 is rejected on the same grounds as claim 4.

Referring to claim 5, Adams does not disclose a data communication system according to claim 1, wherein the first data has positional data indicating a position into which the second data can be inserted.

Armstrong discloses a data communication system according to claim 1, wherein the first data has positional data indicating a position into which the second data can be inserted (column 5, lines 36-41).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the time specific ads taught by Armstrong to the system disclosed by Adams. The motivation would have been to allow the advertisers to provide ads for specific groups, thereby allowing the ads to be more effective.

Claim 15 is rejected on the same grounds as claim 5.

Referring to claim 6, Adams discloses a data communication system according to claim 1, where the second data is transmitted by the transmitting device (figure 3; column 1, line 21).

Claim 16 is rejected on the same grounds as claim 6.

Referring to claim 7, Adams does not disclose a data communication system according to claim 6, wherein the communication terminal transmits a request to transmit the second data from the request transmitting unit to the transmitting device according to the amount of the first data stored in the first storage.

Armstrong discloses a data communication system according to claim 6, wherein the communication terminal transmits a request to transmit the second data from the request transmitting unit to the transmitting device according to the amount of the first data stored in the first storage (column 6, lines 17-18).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the second data request taught by Armstrong to the device disclosed by Adams. The motivation would have been to allow the full bandwidth to be used for the main video enabling a higher quality image.

Claim 17 is rejected on the same grounds as claim 7.

Referring to claim 19, Adams discloses a communication terminal according to claim 13, wherein the communication terminal further comprises a selecting unit for selecting whether to read out the second data or not (figure 3, part 115).

Referring to claim 21, Adams does not disclose a communication terminal according to claim 13, wherein when the display unit displays the second data, display indicating that the second data is being displayed is performed.

Armstrong discloses a communication terminal according to claim 13, wherein when the display unit displays the second data, display indicating that the second data is being displayed is performed (figure 4, part 420).

At the time of the invention it would have been obvious for one of ordinary skill in the art to indicate to the user that the content has been interrupted, as taught by Armstrong, in the device disclosed by Adams. The motivation would have been to indicate the status of the video so the user would not think that the unit had malfunctioned.

Referring to claim 22, Adams does not disclose a communication terminal according to claim 13, wherein the display unit includes a notification unit for notifying display of the second data.

Armstrong discloses a communication terminal according to claim 13, wherein the display unit includes a notification unit for notifying display of the second data (figure 2, part 250).

At the time of the invention it would have been obvious for one of ordinary skill in the art to indicate to the user that the content has been interrupted, as taught by Armstrong, in the device disclosed by Adams. The motivation would have been to indicate the status of the video so the user would not think that the unit had malfunctioned.

Claim 23 is rejected on the same grounds as claims 13 and 19.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adams in view of Armstrong as applied to claim 1 above, and further in view of Zeidman.

Referring to claim 8, Adams and Armstrong do not disclose a data communication system according to claim 1, wherein the transmitting device comprises a bonus information storage for storing bonus information associated with a number of times that the reading unit has read out the second data from the second storage or a period of time required for the reading unit to read out the second data from the second storage; wherein the bonus information is information on a discount on a data transmission charge or bonus point information.

Zeidman discloses a data communication system according to claim 1, wherein the transmitting device comprises a bonus information storage for storing bonus information associated with a number of times that the reading unit has read out the second data from the second storage or a period of time required for the reading unit to read out the second data from the second storage (page 2, column 1, lines 9-12; Note: Zeidman discloses providing discounts for viewing commercials during a broadcast, which would be equivalent to the second data).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the monitor rewarding taught by Walker to the system disclosed by Adams and Armstrong. The motivation would have been to enable advertisers to have conformation that their ads were being viewed and which were not, as a way of deciding which ads are effective.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adams in view of Armstrong in view of Zeidman as applied to claim 8 above, and further in view of Kim.

Referring to claim 9, Adams et al. do not disclose a data communication system according to claim 8, wherein the bonus information is information on a discount on a data transmission charge or bonus point information.

Kim discloses a data communication system according to claim 8, wherein the bonus information is information on a discount on a data transmission charge or bonus point information (page 5, column 2, lines 4-11).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the discounts taught by Kim to the system previously disclosed by Adams et al. The motivation would have been to provide bonuses that would entice and therefore encourage the user to participate in the service.

Claims 10, 11, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams in view of Armstrong as applied to claim 1 above, and further in view of Kirk.

Referring to claim 10, Adams and Armstrong do not disclose a data communication system according to claim 1, wherein when the first data contains inhibit data for inhibiting insertion of the second data into the first data, the control unit performs control over the reading unit such that reading of the second data is stopped.

Kirk discloses a data communication system according to claim 1, wherein when the first data contains inhibit data for inhibiting insertion of the second data into the first data, the control unit performs control over the reading unit such that reading of the second data is stopped (column 1, lines 47-50).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the inhibit signal taught by Kirk to the system disclosed by Adams and Armstrong. The motivation would have been to allow the headend to block certain advertisements to certain areas where the subscribers may find the content to be offensive.

Claims 11 and 18 are rejected on the same grounds as claim 10.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Armstrong in view of Kirk.

Referring to claim 12, Armstrong discloses a transmitting device for transmitting data to a communication terminal comprising: storage means for storing a plurality of data (figure 1, part 122); receiving means for receiving a request to transmit first data from the communication terminal (figure 1, part 126); reading means for reading out the first data from the storage means (figure 3, part 340, part 370);

Armstrong does not disclose a transmitting means for transmitting the first data and inhibit data that inhibits insertion of second data different from the first data into the first data.

Kirk discloses a transmitting means for transmitting the first data and inhibit data that inhibits insertion of second data different from the first data into the first data (column 1, lines 47-50).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the inhibit signal taught by Kirk to the system disclosed by Armstrong. The motivation would have been to allow the headend to block certain advertisements to certain areas where the subscribers may find the content to be offensive.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adams in view of Armstrong as applied to claim 13 above, and further in view of Yoshimoto.

Referring to claim 20, Adams and Armstrong do not disclose a communication terminal according to claim 13, wherein the display unit displays the amount of the first data stored in the first storage.

Yoshimoto discloses a communication terminal according to claim 13, wherein the display unit displays the amount of the first data stored in the first storage (figure 19).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the buffer capacity output taught by Kaminski to the system disclosed by Adams and Armstrong. The motivation would have been to enable the subscriber to see how much time is left in the first program.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin E. Shepard whose telephone number is (571) 272-5967. The examiner can normally be reached on 7:30-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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